



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/933,500	09/18/1997	ROBERT FILEPP	1963-4727	6468

7590

11/07/2002

ISRAEL BLUM
MORGAN & FINNEGAN
345 PARK AVENUE
NEW YORK, NY 10154

EXAMINER

DINH, DUNG C

ART UNIT	PAPER NUMBER
----------	--------------

2153

DATE MAILED: 11/07/2002

#1

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/933,500

Applicant(s)

FILEPP ET AL.

Examiner

Dung Dinh

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Prosecution is being reopened on this application because further review of the copied claims shows the application is not in condition for allowance. As not all matters were adequately addressed in the earlier prosecution of this application; as some new information that raise substantial issues as to patentability has recently come to the attention of the examiner [the result of the review of the reconstructed application 07/388,156 and art cited in one of applicants' related applications on appeal (see the 35 USC § 102(b) discussion which follows)]; and because of double patenting rejections resulting from the issuance of some of applicants' other applications during the intervening period, the applicants will find that this Office action addresses the now determined remaining outstanding issues and rejections. A declaration of interference with U.S. Patent 5,528,490 (Hill '490) would be premature until all matters involving these grounds of rejections are resolved. The Office regrets any inconvenience that may have arisen from the delay in the prosecution of this application. This application will receive expedited priority in all matters wherever possible to mitigate any impact caused by these developments.

Structure of Rejections/Remarks

2. Unless otherwise specified, the discussion and rejections are addressed to the concepts contained in applicants' independent Claim 33. The examiner notes there are actually four independent claims, Claims 33, 47, 62 and 67. The fundamental differences between the claims are as follows:

Claim 33: A method for generating product information for "at least one product."

Claim 47: A method for producing information related to "a plurality of products."

Claim 62: An apparatus for an electronic catalog system related to "at least one product."

Claim 67: An apparatus for an electronic catalog system related to "a plurality of products."

Claims 62 and 67 are "means plus function" claims.

Art Unit: 2153

3. From most of the record to date, applicants' remarks have focused on the concepts contained in Claim 33. It appears Claim 33 is the broadest method claim and for comparison to the method claim of application 08/158,026, this is the claim most similar in scope. Therefore, the focus of the analysis of this Office action is on Claim 33 and the other independent claims are generally interpreted as being included in the analysis or rejections.

Claim Rejections - 35 USC § 101

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states, "whoever invents or discovers any new and useful process ... may obtain a patent therefore..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

5. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claim 33 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 5,758,072 issued to Filepp et al., on May 26, 1998. This is a double patenting rejection. This rejection is based, in part, on applicants' admissions and remarks contained in the "Request for Declaration of an Interference under 37 CFR § 1.607" filed on September 18, 1997. In that paper, applicants' set forth their support for copying the patented claims found in U.S. Patent 5,528,490 (Hill '490). The applicants state on page 1 of the request:

The instant application [08/933,500], a continuation of Application Serial No. 08/740,043 ('the 043 application') filed October 23, 1996, was filed specifically to provoke an

Art Unit: 2153

interference with the Hill '490 patent by presenting claims therein that correspond to the same subject matter claimed in Claims 1-40 of the Hill '490 patent.

Further, on page 2, lines 1-5, of that paper, applicants state:

Applicants should be named as the senior party in the interference because Hill's earliest effective filing date is April 10, 1992, which is later than the effective filing date of July 28, 1989 to which Applicants are entitled. *At least one claim—Claim 10—of the '043 application was directed to the same subject matter as the Hill '490 patent claims*, in accordance with 35 U.S.C. § 135(b). [Emphasis added.]

Page 4 *et seq.* of the "Request for Declaration of an Interference Under 37 CFR § 1.607" sets forth a detailed summary by applicants as to why Claim 10 of application 08/740,043 is the same subject matter as Hill '490 (a total of 14 pages of remarks).

On March 5, 1999, applicants filed an amendment in this application (08/933,500) and a supplemental request for declaration of an interference which shifted the basis for satisfying 35 USC § 135(b) from Claim 10 of 08/740,043 to Claim 1 of 08/158,026 (the version which was pending from December 21, 1994 until April 12, 1996). The apparent reason for this modification was due to the issuance of Claim 10 as Claim 1 in U.S. Patent 5,758,072 on May 26, 1998.

Essentially by applicants' own admissions filed on September 18, 1997, they have set forth the case for a statutory double patenting rejection between pending Claim 33 and their Claim 1 from U.S. Patent 5,758,072 which is set forth below:

Claim 1. A method for operating a computer network having a multiplicity of reception systems at which respective users can request applications that include interactive services, the method comprising the steps of:

organizing the applications as objects, the objects collectively including data and executable program instructions for generating the applications;

distributing objects within the network in accordance with a predetermined plan; and

supplying objects to a respective reception system at which an application is requested to enable the respective reception system to selectively collect objects required for the application from the respective reception system and to the extent objects required for the application are unavailable at the respective reception system, to collect required objects not at the respective reception system from the network other than the respective reception system so that the requested application can be presented at the respective reception system based on the objects collected.

And Claim 33 of this application, which is set forth below:

Claim 33. A method for generating information related to a product, the method comprising the steps of:

storing and maintaining variable data and constant data related to at least one product and a main revision status in a memory of a main computer, the main revision status indicating the revision level of the constant data stored in the main computer;

storing constant data related to the at least one product and a remote revision status in a memory of a remote computer, the constant data being a subset of information data related to the at least one product, the remote revision status indicating the revision level of the constant data stored in the remote computer;

transmitting the remote revision status from the remote computer to the main computer;

comparing the remote revision status with the main revision status;

Art Unit: 2153

updating constant data stored in the memory of the remote computer with constant data maintained in the memory of the main computer that is different from the constant data stored in the memory of the remote computer;

transmitting variable data related to the at least one product from the main computer to the remote computer; and

integrating constant data related to the at least one product with the variable data related to the at least one product in the remote computer to generate the information data related to the at least one product including both constant data and variable data.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time wise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 34-72 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,758,072. Although the conflicting claims are not identical, they are not patentably distinct from each other because

Art Unit: 2153

applicants have admitted they are directed to the same subject matter. Applicants filed a "Request for Declaration of an Interference Under 37 C.F.R. § 1.607" on September 18, 1997. In that paper, on page 7, *inter alia*, applicants state "Although Hill's Claims 1-40 [currently applicants Claims 33-72] and Filepp Et Al. Claim 10 [issued as Claim 1 of U.S. Patent 5,758,072] Use Different Terminology, They are Directed to the Same Subject Matter." (The bracketed comments are added for clarification.) As applicants are making a comparison between one claim and *forty claims*, (the forty claims now pending in this application); it would appear applicants could be implying that claims 34-72 are not further limiting which would raise an issue under 35 USC 112, fourth paragraph. However, upon review, the examiner finds the dependent claims are further limiting and applicants' statement is taken to be an admission that they are obvious variations. Therefore the claims are rejectable for nonstatutory double patenting. The reasons supporting this rejection are incorporated from applicants' admissions on pp. 7-16 in the "Request for Declaration of an Interference Under 37 CFR § 1.607."

9. Claims (33-34, 43-46), (47, 57-60), (62, 64-66), and (67, 70-72) are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of prior U.S. Patent No. 6,182,123, issued to Filepp et al., on January 30, 2001.

Claims 67, 70-72 of the present application recites identical limitations as claims 1-5 of patent 6,182,123:

U.S. patent 6,182,123	08/933500 (Present application)
<p>1. A system for automatically updating a program stored in a remote computer, the system comprising:</p> <p>a remote computer including a remote memory for storing a program and a remote revision status,</p> <p>the remote program revision status indicating the revision level of the program stored in the remote memory,</p>	<p>67. An electronic catalog system comprising: ...</p> <p>72. The system of claim 67, further comprising</p> <p>means for storing a program and a remote program revision status in the memory of the remote computer,</p> <p>the remote program revision status indicating the revision level of the program stored in the memory of the remote</p>

<p>a main computer including a main memory for storing the latest revisions of the program and a main program revision status,</p> <p>the main program revision status indicating the revision level of the program stored in the main memory;</p> <p>means for transmitting the remote program revision status from the remote computer to the main computer;</p> <p>means for comparing the remote program revision status to the main program revision status;</p> <p>means for determining which portions of the program stored in a main memory are different from the program stored in the remote memory;</p> <p>means for transmitting updated portions of the program stored in the main computer to the remote computer;</p> <p>means for replacing portions of the program stored in the remote computer with updated portions of the program received from the main computer; and</p> <p>means for transmitting the new program revision status from the main computer to the remote computer.</p> <p>2. The system of claim 1, further comprising</p> <p>means for storing and maintaining variable data and constant data related to a plurality of products in the memory of the main computer,</p> <p>means for storing constant data related to a plurality of products in the memory of the remote computer,</p>	<p>computer,</p> <p>means for maintaining the latest revisions of the program and a main program revision status in the memory of the main computer,</p> <p>the main program revision status indicating the revision level of the program stored in the memory of the main computer,</p> <p>means for transmitting the remote program revision status from the remote computer to the main computer,</p> <p>means for comparing the remote program revision status to the main program revision status,</p> <p>means for determining updated portions of the program stored in the main computer that are different from the program stored in the remote computer,</p> <p>means for transmitting the updated portions from the main computer to the remote computer, and</p> <p>means for replacing portions of the program stored in the memory of the remote computer with the updated portions received from the main computer.</p> <p><i>(inherent in the step of transmitting updated portions of the program.)</i></p> <p>(claim 67)</p> <p>a main computer including a main memory for storing variable data and constant data related a plurality of products;</p> <p>a remote computer including a remote memory for storing constant data related to a plurality of products, the constant data being a subset of product information data related to the</p>
--	--

Art Unit: 2153

<p>means for selecting a product from the remote computer memory for which product information is desired,</p> <p>means for comparing constant data in the memory of the remote computer with constant data in the memory of the main computer,</p> <p>means for determining updated portions of the constant data stored in the main computer that are different than the constant data stored in the remote computer,</p> <p>means for transmitting the updated portions of the constant data stored in the main computer from the main computer to the remote computer, and</p> <p>means for replacing portions of the constant data stored on the remote computer with the updated portions of constant data received from the main computer.</p> <p>3. The system of claim 2, further comprising means for integrating constant data stored in the memory of the remote computer associated with the selected product with the variable data received from the main computer to provide information related to the selected product including both constant and variable data.</p>	<p>plurality of products;</p> <p>means for transmitting a request for variable data related to a selected product from the remote computer to the main computer;</p> <p>means for comparing constant data in the remote memory with constant data in the main memory;</p> <p>means for determining which portions of the constant data stored in the main memory are different from the constant data stored in the remote memory;</p> <p>means for transmitting updated portions of the constant data stored in the main memory from the main computer to the remote computer;</p> <p>means for replacing portions of the constant data stored in the remote memory with the updated portions of constant data received from the main computer;</p> <p>means for transmitting variable data related to the selected product stored in the main memory from the main computer to the remote computer; and</p> <p>means for integrating constant data related to the selected product stored in the remote memory with the variable data related to the selected product received from the main computer to generate the product information data related to the selected product including both constant data and variable data.</p>
<p>4. The system of claim 2, further comprising</p> <p>means for storing and maintaining a main constant data revision status in the memory of the main computer,</p>	<p>70. The system of claim 67, further comprising</p> <p>means for storing and maintaining a main revision status in the memory of the main computer,</p>

Art Unit: 2153

<p>the main constant data revision status indicating the revision level of the constant data stored in the main computer,</p> <p>means for storing a remote constant data revision status in the memory of the remote computer, and</p> <p>the remote constant data revision status indicating the revision level of the constant data stored in the remote computer.</p> <p>5. The system of claim 4, wherein</p> <p>the means for comparing constant data in the memory of the remote computer with constant data in the memory of the main computer compares the remote constant data revision status with the main constant data revision status maintained in the main computer.</p>	<p>the main revision status indicating the revision level of the constant data stored in the main computer, and</p> <p>means for storing a remote revision status in the memory of the remote computer,</p> <p>the remote revision status indicating the revision level of the constant data stored in the remote computer.</p> <p>71. The system of claim 70,</p> <p>wherein the means for comparing constant data in the remote memory with constant data in the main memory compares the remote revision status with the main revision status maintained in the main computer.</p>
<p>6. The system of claim 5, wherein</p> <p>the means for transmitting updated portions of the constant data stored in the main memory from the main computer to the remote computer also transmits an updated remote revision status identical to the main revision status from the main computer to the remote computer.</p>	<p>(claims 43 and 58)</p> <p>43. The method of claim 42, wherein the constant data updating step further includes the step of transmitting a new remote revision status identical to the main revision status from the main computer to the remote computer.</p>

Although claims 1-5 of the patent and the claims (67, 70-72) in the present application are not word for word the same, they recite the same scope as shown by the mapping above.

Claims (62, 64-66) of the present application recite the same scope as the patent's claims 1-5 for the same reason stated above for claims (67, 70-72).

Claims (33-34, 43-45) and (47, 57-60) are method claims. However the patent's claims 1-6 are in means plus function form reciting means for performing steps identical to the steps

Art Unit: 2153

recite by claims (33-34, 43-45) and (47, 57-60). Hence, the patent's claims 1-6 are equivalent to the method claims (33-34, 42, 44-45) and (47,53, 57-60) of the present application.

For these reasons the claims of the present application are not patentably distinct from the claims of U.S. Patent 6,182,123.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 35-36, 48-49, and 62-72 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specific subject matter is not found in the instant application or in any of the parent applications.

11. Claims 35-36, 48-49 and 68-69 recite the steps of automatically connecting the remote computer to the main computer after the selecting step, and automatically disconnecting after the variable data is received. These steps are not disclosed nor suggested in applicants' specification.

12. Claims 62-72 are rejected under 35 U.S.C. 112, first paragraph, because they are drawn to an electronic catalog system. As noted in applicants' table on page 43, for example, applicants' disclosure is for an electronic system, but not specifically for an electronic catalog system.

Claim Rejections - 35 USC § 102/103

13. Applicants have copied claims 33-72 from U.S. Patent 5,528,490 (Hill '490) and have set forth remarks in Paper No. 5, filed March 5, 1999, that substantially the same invention was pending as Claim 1 in earlier filed application 08/158,026, as amended on December 21, 1994 until further amending on April 12, 1996. Subsequent to that amendment, the examiner indicated the claim was allowed and U.S. patent 5,594,910 issued on January 14, 1997. The examiner maintains that Claim 1 of 08/158,026, prior to the April 12, 1996 amendment, was properly rejected using Johnson et al.. A reading of the analysis of a rejection over Johnson et al. in view of the language of Claim 1 of '026 is found in the footnote.¹

¹ Re Claim 1: Johnson et al. discloses a method for operating a computer network with a stated purpose of alleviating the problems associated with the "time required to transmit data across the network for successive reads and writes." (Col. 2, lines 58-59.) "The invention is specifically concerned with distributed data processing systems characterized by a plurality of processors interconnected in a network." (Col. 3, lines 61-63.) Johnson et al. discloses the steps of:

a) establishing data stores at the host computers, the concentrator computers and the reception system computers. Johnson et al. discloses a "server" defined as a processing system where the file or application is permanently stored and "client" means any other processing system having processes accessing the file. (Col. 2, bottom to Col. 3, top.) Johnson et al. therefore has host computers and concentrator computers called the "server" and reception system computers called the "client." The specification also discloses that "[i]n this environment, each processor at a node in the network potentially may access all the files in the network no matter at which nodes the files may reside." (Col. 4, lines 26-29.)

b) distributing application data in accordance with a predetermined plan to data stores maintained, respectively, at the host computers, the concentrator computers and the reception system computers, the predetermined plan being implemented, at least in part, by ascribing a storage control attribute to the application data, the control attribute dictating eligibility of the application data for storage. Johnson et al. discloses an invention which "is specifically concerned with distributed data processing systems" (see Col. 3, lines 61-62) in accordance with a predetermined plan (see Col. 5, lines 9-21) which allows the reception system (the client cache 12B) "to access a remote file 5 [which] can significantly improve the performance since it can save network traffic and overhead." (Col. 6, lines 59-61.) Johnson et al. further discloses the predetermined plan is implemented, at least in part, by ascribing a storage control attribute which is characterized as "file handle, node identifier, and logical block number". If these

Art Unit: 2153

It is the examiner's position that Claim 1 of application 08/158,026 (as amended on December 21, 1994) *is not substantially the same invention* as Claims 33-72 pending in the instant application 08/933,500. Because of the position that the subject matter before and after the amendment are patentably distinct, no art rejection of Claim 33 based upon Johnson et al. is presented. The examiner has made a rejection under 35 USC § 135(b) in this Office action.

Inquiry under 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

are in the client cache (i.e., the reception system computer), then the information in the cache is read, but if it isn't there, the server is accessed. (See Col. 9, lines 19-24 or Figure 9.)

c) supplying application data to a respective reception system computer at which an application is requested so that the respective reception system computer can assemble the data which makes up the requested application by selectively collecting data from its own data store and the data stores of the respective host computer and concentrator computer to which it is connected. Johnson et al. discloses synchronization modes (ASYNCH 141, FULLSYNC 143, etc.) which can control the assembly of data at the client cache (i.e., the reception system computer). (See, for example, Col. 9, bottom - Col. 11, top; specifically, Col. 10, line 64 - Col. 11 line 5.) The network is designed to ensure all versions of the file or application data are consistent between the server and the client cache through a synchronization check (i.e., a storage control attribute). The server verifies the client cache version and if it is not the same as the server's version, an ASYNCH mode is assigned which permits the client to work locally (see Fig. 5). When the server and the client cache have the same version, then the mode is designated FULLSYNC (see Fig. 8 for operation). "When file changes sync mode from ASYNC to FULLSYNC, the server notifies the client of the change, and the client writes all of the file's modified blocks to the server and discards any unmodified blocks." (See Col. 11, lines 1-5.) This results in the client cache (the reception system computer) having assembled data collected from its own data store and the data stores of the server (the host computer) to which it is connected.

Art Unit: 2153

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. An issue as to the patentability of the claimed subject matter because of public use or on sale activity has been raised by the applicant in this application. It is necessary to resolve this issue before a conclusion as to the patentability of the claimed subject matter can be reached. In the recently reconstructed application 07/388,156 (now U.S. Patent 5,347,632), a paper was found which was a disclosure statement by applicants' representative, Mr. Paul Scifo. The paper was filed under 37 CFR 1.97 (Paper no. 13, filed March 4, 1991) and it addresses matters regarding possible public use or on sale in this country more than one year prior to the date of the application for patent. In the preliminary papers filed on September 18, 1997 in the instant application (08/933,500), Mr. Israel Blum makes the statement:

Applicants should be named as the senior party in the interference because Hill's earliest effective filing date is April 10, 1992, which is later than the effective filing date of July 28, 1989 to which Applicants are entitled.

Since the July 28, 1989 date is the filing date of application 07/388,156, it appears applicants are conceding the priority of two of the related applications, which date back to July 15, 1988 (for original filed application 07/219,931). The record is therefore unclear relating to the dates stated in the disclosure statement filed March 4, 1991 for the public use or on sale of the *currently claimed invention*.

16. The disclosure refers to three phases of testing and development extending over almost two years (see page 15, lines 1-4).

Art Unit: 2153

Phase I

January-September '87 "testing was conducted confidentially by Prodigy employees and outside consultants". Goal: To "establish the viability of the general concept."

Phase II

October '87- March'88 Testing expanded to 3 groups of approximately 100 people each. Goal: (1) to determine if the service would continue to operate with users who were not involved in the development, and (2) to fix problems as they occurred.

Phase III

April-August 1988 "Founding Members". Goal: Public testing "over a broader user base to see if the reception system and Service would continue to operate." [page 20, lines 10-16]

=====

17. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required, and must be submitted with the response to this Office action as part of a complete reply, as follows:

- a) The statement is signed by the attorney of record. Please respond as to whether this statement is a personal knowledge, firsthand account. It is being treated as an admission by applicants through their appointed representative. Any information necessary to refute statements made herein must be made in the form of evidence.
- b) The disclosure statement contains many statements regarding the development of the service through various phases. As there is no **substantive** discussion of what features were implemented in the various releases/versions, applicants are required to

Art Unit: 2153

provide evidence to clarify the relationship between the **currently pending claims** and the initial implementation and all subsequent significant revisions, and in particular to indicate the revision level and date of implementation that the service met the currently claimed subject matter.

- c) As the statement's introductory section appears to be a list of features embodied in the original design that appears to encompass the details of all the claims, applicants are required to provide evidence of what **claimed** features were not present in the original embodiment, particularly by identifying at what stage/revision each missing claimed feature was added. This evidence should include dates wherever possible.
- d) Applicants are required to provide evidence to explain what each stage of experimentation was designed to test. This evidence is to also indicate what features had been added, enhanced and/or improved at each deployment.
- e) Applicants are required to provide copies of documentation supplied to any testers at each of the phases. This documentation should include, but is not limited to, a description of the service, test conditions or goals, any restrictions on use and dissemination, and contracts/agreements regarding confidentiality.
- f) Applicants are required to clarify the relationship between the testing and the currently pending Claims 33-72 and identify when and what types of substantive changes were made at each deployment or revision. A table lining up claimed elements and the testing phases would be a useful format for conveying this relationship.
- g) Applicants are required to state what measures were in place to ensure the confidentiality discussed on page 17 of the disclosure statement.
- h) Since the disclosure statement states there were no confidentiality requirements during Phase III when using 2600 additional members of the public ("the Founding Members," see page 21, lines 23-24) during the period of April – August 1988, more information is needed from applicants to resolve the issue as to public use. The implementation and functionality of the system at this stage and any evidence which

Art Unit: 2153

applicants believe would support a conclusion of non-public use would be of great value to the examination process.

- i) According to the disclosure, the Founding Members were given an option to get an extension of service at a reduced rate (see page 21, lines 2-4). Applicants are required to describe these offers including the dates they were made. Applicants are also required to submit information regarding responses to these offers including the dates of the first acceptance of any of these offers.
- j) Applicants are required to provide information regarding the sponsor agreements and the "understanding with approximately 6 chain distributors." (See page 24, 2nd and 3rd paragraphs.) The contracts in place and any evidence of either oral or written agreements should be provided wherever possible.
- k) Applicants may wish to submit evidence that the revised version release which occurred on or about August 5, 1988 had significant differences from the previous versions which may be reflected in the currently pending Claims 33-72.

The examiner takes note of the disclosure statements' citation of case law that addresses the interplay between experimental and public use; control and incidental payments. As mentioned in the statement, the determination is based on the totality of the circumstances. Therefore the examiner needs the required information and evidence in order to evaluate the facts and resolve the patentability issue as to whether applicants' actions constitute a statutory bar.

In responding to this inquiry, applicants are also advised to carefully consider the references cited on the PTO-892 relating to the Trintex system (now known as "Prodigy"), its design and deployment. This art dates back to 1987 and appears to outline applicants' invention, particularly in articles dated Sep 8, 1987, October 12, 1987, and November 30, 1987.

Applicants are reminded that this requirement is an integral part of this Office action, and failure to fully reply to this requirement for information will result in a holding of abandonment.

Claim Rejections - 35 USC § 135(b)

35 U.S.C. § 135 Interferences

(b)(1) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

(b)(2) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an application published under section 122(b) of this title may be made in an application filed after the application is published only if the claim is made before 1 year after the date on which the application is published.

18. Claims 33-72 are rejected under 35 U.S.C. § 135(b) as not being made prior to one year from the date on which U.S. Patent No. 5,528,490 (Hill '490) was granted. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed. Cir. 1997) where the Court held that the application of 35 U.S.C. § 135(b) is not limited to *inter partes* interference proceedings, but may be used as a basis for *ex parte* rejections. Claims 33-72 were presented on September 18, 1997 as copied from Hill '490 which issued on June 18, 1996. To overcome the fact the copied claims were not made in this application until **1 year and 3 months** after the issue date of the Hill '490 patent, applicants state this same subject matter was made in application 08/158,026 in Claim 1 that was amended on December 21, 1994 until again amended on April 12, 1996.

19. Claim 1 of application 08/158,026, as amended December 21, 1994 (and pending until April 12, 1996), was rejected under 35 USC 103 in view of Johnson et al. in the prosecution of application 08/158,026. Applicants' argue that pending copied claims 33-72 are substantially the same as Claim 1 of 08/158,026. However, it is the examiner's position the copied claims **are not** substantially the same subject matter as Claim 1 of application 08/158,026 for the reasons set out below.

Art Unit: 2153

20. The examiner is aware a rejection under 35 USC § 135(b) was previously made in Paper no. 3, mailed October 1, 1998 on Claims 33-72. That rejection was based on applicants' remarks in the "Request for Declaration of an Interference under 37 CFR § 1.607" that at least Claim 10 of the parent application 08/740,043 was directed to the same subject matter as the Hill 5,528,490 patent which issued on June 18, 1996. On March 5, 1999, applicants filed an amendment and a supplemental request for declaration of an interference which shifted the basis for satisfying 35 USC § 135(b) from Claim 10 of 08/740,043 to Claim 1 of 08/158,026. The apparent reason for this modification was due to the issuance of Claim 10 as U.S. Patent 5,758,072, Claim 1. This matter has been discussed above and is the grounds for a statutory double patenting rejection. Subsequent to applicants filing of "Subsequent Request for Declaration of an Interference Under 37 CFR § 1.607" on March 5, 1999 (Paper no. 5), the examiner of record appears to have withdrawn the 35 USC § 135(b) rejection of Claims 33-72 without comment. However, the record is not complete and one of the matters that has not been adequately addressed is as follows:

- Applicants stated that Claim 10 of 08/740,043 was the same as Hill '490 claims 1-40 (see filing of September 18, 1997). The USPTO cannot by statute declare an interference between two patents, i.e. the patents of Filepp et al. 5,758,072 and Hill '490 (note: Claim 10 is now Claim 1 of U.S. Patent 5,758,072). The fact that applicants are now attempting to rely on an unpatented, earlier filed, claim (from application 08/158,026) was not fully explained in applicants' responses. From the record, it appears the applicants' have equated their two previous claims [found in 08/158,026 and 08/740,043] and Claims 1-40 in Hill '490 as being directed to the same (or substantially the same) subject matter for §135(b) purposes. Further clarification from applicants is needed to explain the reasons for the change in the §135(b) claim designation between the claim in 08/740,043 and 08/158,026.

21. Applicants' representative set forth extensive arguments as to why Claim 1 of 08/158,026, pending from December 21, 1994 until April 12, 1996 is directed to the same

Art Unit: 2153

subject matter as copied claims 33-72 which would obviate a grounds of rejection under 35 USC § 135(b) since the Hill patent issued June 18, 1996. Applicants' support is set forth in Paper No. 5, filed March 5, 1999 starting at page 4. These arguments are not found persuasive for the reasons set forth below.

Standard of review

22. On page 5 of the remarks, applicants cite 37 CFR § 1.601(n) and *Fiddes v. Baird*, 30 USPQ2d 1481, 1484-85 (Bd. Pat. App. & Interf. 1993) in support of the concept that applicants were claiming substantially the same subject matter "prior to one year from the date on which the Hill '490 patent was granted." The opinion in *Fiddes*, however, related to the test for interference-in-fact under 35 USC 135(a) and not to the test for a bar under 35 USC 135(b), "[t]he test for interference-in-fact is set forth in Section 1.601(n)." The examiner disagrees that Rule 601(n) is the standard for this inquiry under 35 USC § 135(b), but rather the standard is whether "the essential patentable subject matter is the same in each case." *Reiser v. Williams*, 118 USPQ 96, 99 (CCPA 1958) as reiterated in *Berman v. Housey*, 63 USPQ 2d 1023 (CAFC 2002). In *Berman v. Housey*, the court notes the Board of Patent Appeals and Interferences (BPAI) had rejected Berman's arguments that for purposes of establishing an interference, the inquiry "is governed by the obviousness standard of 35 U.S.C. § 103," which is the standard that also governs whether an application claims the 'same patentable invention' for purposes of establishing an interference under 35 U.S.C. § 135(a) and 37 C.F.R. § 1.601(n)." The Board determined that the claim at issue "did not enable Berman to avoid the § 135(b) bar under the test set forth" in *Reiser v. Williams*. *Id.* at 1026. [It should be noted that the court did not further address Berman's arguments because Berman did not challenge it. See Footnote, *Berman v. Housey*, 63 USPQ 2d 1023, 1030 (CAFC 2002).] Further, *In re Berger*, 61 USPQ2d 1523 (CAFC 2002) specifically states that entitlement to the earlier effective filing date for claims for purposes of the one-year bar of 35 U.S.C. § 135(b) is a distinctly different question from whether claims made for purposes of interference by different parties are directed to interfering subject matter. ***The comparison standard of 37 C.F.R. § 1.601(n) was formulated not to determine the effective date of a claim in one party's application for compliance with §135(b), but instead to***

Art Unit: 2153

define the extent of interfering subject matter as between applications of potentially conflicting parties. *Id.* at 1527. (Emphasis added.)

23. Therefore, the standard of inquiry that the examiner is applying is whether applicant's Claims 33-72 contain the essential patentable subject matter as was claimed in Claim 1 of 08/158,026 (pending from December 21, 1994 until amended on April 12, 1996). To do this, applicants "must show that the later filed claim does not differ from an earlier claim in any 'material limitation.'" *Id.* at 1527 citing *Corbett v. Chisholm*, 196 USPQ 337 (CCPA 1977). A material limitation is something "necessary to patentability." *Corbett v. Chisholm*, 196 USPQ 337, 343 (CCPA 1977).

24. To review these claims for a discussion of § 135(b) issues, Claim 1 of application 08/158,026 (pending from December 21, 1994 until April 12, 1996) and Claim 33 of this application (08/933,500) they are reproduced and diagramed as follows:

Art Unit: 2153

08/158,026:

Claim 1 (as amended, December 21, 1994). A method for operating a computer network so as to provide a multiplicity of users access to a multiplicity of applications, the applications each including data, the network having one or more host computers, a plurality of concentrator computers connected in groups of one or more to each of the host computers, and a plurality of reception system computers at which respective users may request applications, the reception system computers being connected in groups of one or more to each of the concentrator computers, the method comprising the steps of:

a. establishing data stores at the host computers, the concentrator computers and the reception system computers;

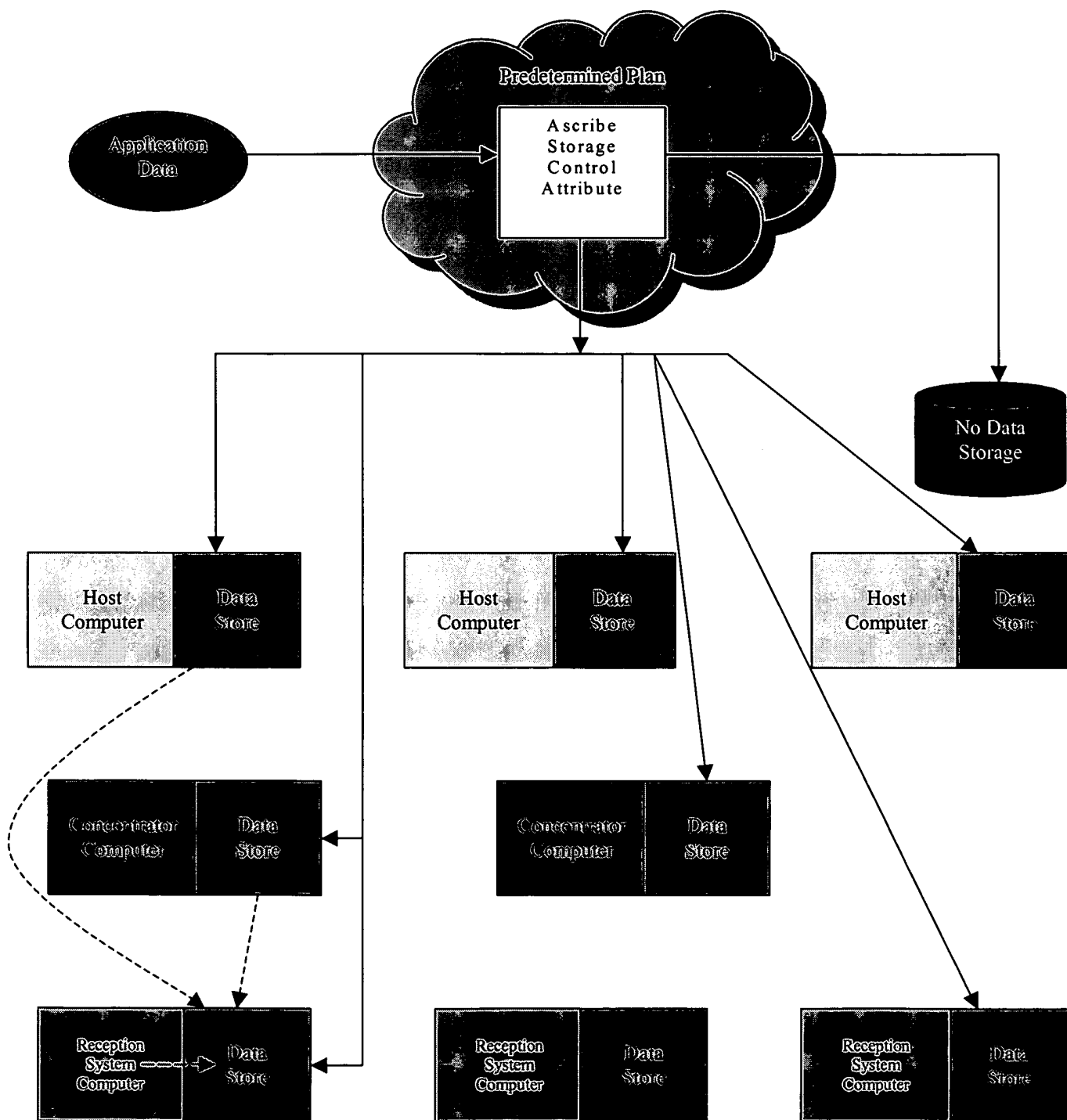
b. distributing application data in accordance with a predetermined plan to data stores maintained, respectively, at the host computers, the concentrator computers and the reception system computers, **the predetermined plan being implemented, at least in part, by ascribing a storage control attribute to the application data, the control attribute dictating eligibility of the application data for storage;** [Amendment A, filed Dec 21, 1994] and

c. supplying application data to a respective reception system computer at which an application is requested so that the respective reception system computer can assemble the data which makes up the requested application by selectively collecting data from its own data store and the data stores of the respective host computer and concentrator computer to which it is connected.

[See diagram of Claim 1 on next page.]

Art Unit: 2153

**Diagram of Claim 1 of 08/158,026 (Filepp et al.)
(Pending December 1994 – April 1996)**



Key:

Selectively collected application data

Application data w/ storage control attribute

—————

Art Unit: 2153

08/933,500:

Claim 33 (filed September 18, 1997 and copied from Hill '490) A method for generating information related to a product, the method comprising the steps of:

(Step a) storing and maintaining variable data and constant data related to at least one product and a main revision status in a memory of a main computer, the main revision status indicating the revision level of the constant data stored in the main computer;

(Step b) storing constant data related to the at least one product and a remote revision status in a memory of a remote computer, the constant data being a subset of information data related to the at least one product, the remote revision status indicating the revision level of the constant data stored in the remote computer;

(Step c) transmitting the remote revision status from the remote computer to the main computer;

(Step d) comparing the remote revision status with the main revision status;

(Step e) updating constant data stored in the memory of the remote computer with constant data maintained in the memory of the main computer that is different from the constant data stored in the memory of the remote computer;

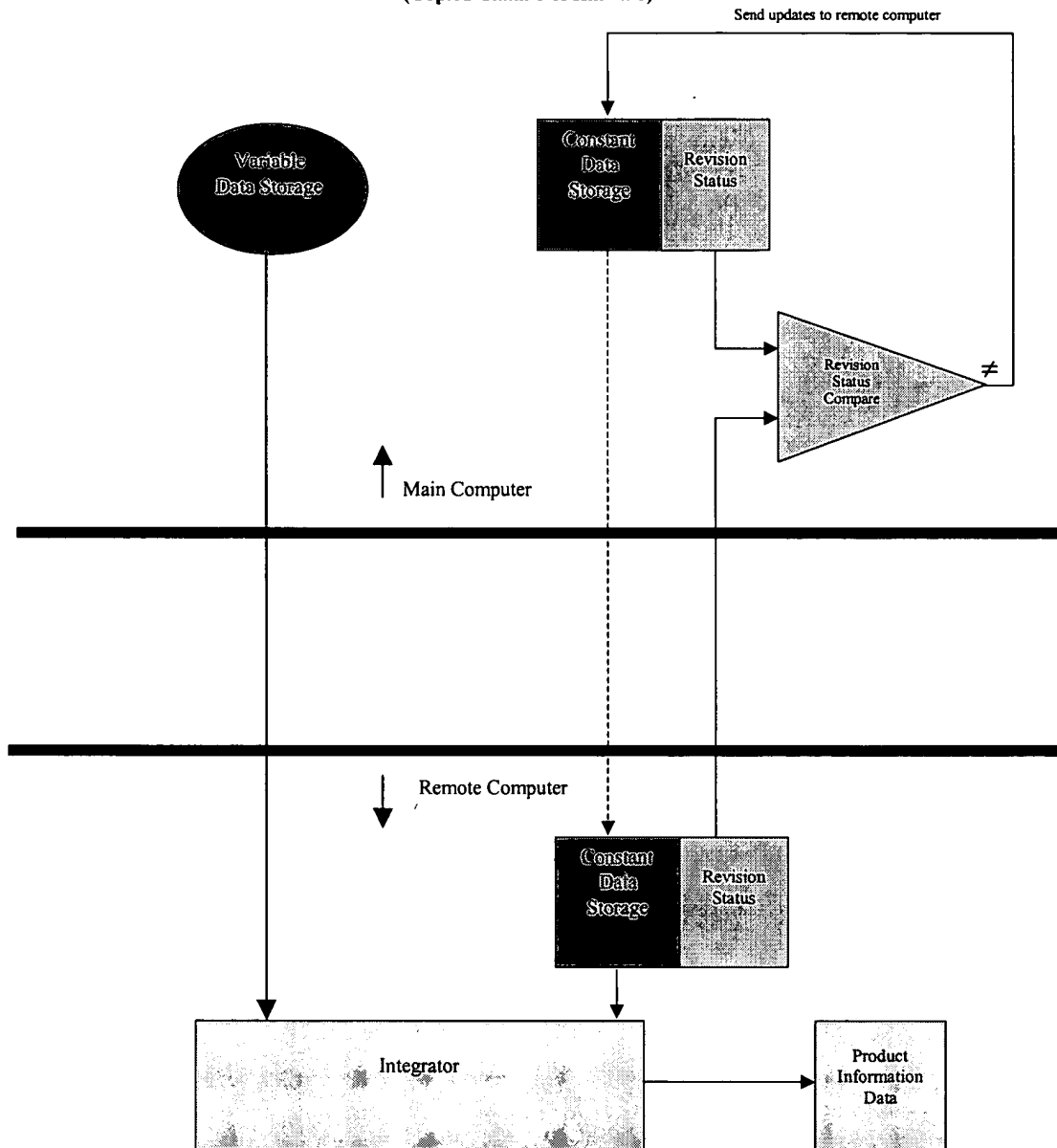
(Step f) transmitting variable data related to the at least one product from the main computer to the remote computer; and

(Step g) integrating constant data related to the at least one product with the variable data related to the at least one product in the remote computer to generate the information data related to the at least one product including both constant data and variable data.

[The parenthetical steps are added to facilitate the claim analysis below.]

Art Unit: 2153

Diagram of Claim 33 of 08/933,500
(Copied Claim 1 of Hill '490)



25. Is the essential patentable subject matter the same in both Claims 33 of 08/933,500 and Claim 1 of 08/158,026 (the version from December 21, 1994 until amended on April 12, 1996)? Have applicants shown that the later filed claim does not differ from the earlier claim in any "material limitation"?

Art Unit: 2153

Material limitations analysis

26. Here are the material limitations which differ between Claims 1 of 08/158,026 and 33 of 08/933,500:

Revision status vs. storage control attribute:

Claim 33 compares the revision status **in the main computer** (Steps c-d). The revision status is for the **constant data only** (Steps a and b).

Claim 1 is silent: the storage control attribute is implemented by the predetermined plan, but the location of the comparison (or even **if** a “comparison” occurs is omitted from the claim) (Step b). The claim is also silent regarding what type of data have these attributes other than the claimed “application data.”

Conclusion: Claim 33 has material limitations not found in Claim 1.

Direction of data transmission:

Claim 33 transmits constant data **from** the main computer to the remote computer (Step e) and transmits variable data **from** the main computer to the remote computer (Step f) (the only communication from the remote computer to the main computer is the revision status for the constant data).

Claim 1 has data distributed **to** host computers, concentrator computers and the reception system computers (Step a). Data collected in the reception system computer can come from the data stores of the host **and** concentrator computers (Step c).

Conclusion: Claims 1 and 33 have different material limitations not found in the other.

Art Unit: 2153

Updating of data:

Claim 33 **updates** the constant data in the remote computer based on the revision status **if** the constant data is different than the main computers' data (Step e).

Claim 1 **stores** data according to a storage control attribute that dictates "eligibility of the ... data for storage" (Step b). It is unclear if the application data are variable, constant, both, or other. The criterion for "dictating eligibility" of the data for storage is omitted from the claim. The claim language also suggests some data are not stored at all if eligibility is "denied" (see Step b).

Conclusion: Claims 1 and 33 have different material limitations not found in the other.

Integrating or assembling of data:

Claim 33 integrates the variable (from the main computer – Step f) and constant data in the remote computer (Step g). The constant data are selected from one of two possible sources - the remote computer or as an **update** from the main computer (Steps b and e).

Claim 1 sets up an optional step of assembly ("can assemble") in the reception system computer through "selectively collecting data" from **three sources** – host computer, concentrator computer and reception system computer. The selectively collected data are not specified as to whether they are constant data, variable data, both or other.

Conclusion: Claims 1 and 33 have different material limitations not found in the other.

Distribution of variable data:

Claim 33 **always** has a step of transmitting variable data from the main computer to the remote computer (Step f). This transmission is one-way from the main to the remote computers for the variable data.

Art Unit: 2153

Claim 1 distributes data in accordance with a “predetermined plan” to storage at the host, **concentrator computers** and reception system computers (Step b). The claim is silent as to what type of data are distributed –variable, constant, other or all? The claim just states “application data”. The claim omits a specific step whereby variable data are always transmitted to the reception system computers.

Conclusion: Claim 33 has material limitations not found in Claim 1.

Data types:

Claim 33 only has limitations regarding variable and constant data (Step a) – two classes of data.

Claim 1 has “application data” without differentiation (Step b) to variable or constant data. Application data could be **all** data relating to an application (the full package) not just two classes of data. The claim is silent as to whether Step c involves transmission of one class, two classes or all types of data to the reception system computer.

Conclusion: Claims 1 and 33 have different material limitations not found in the other.

27. The examiner maintains the applicants have not met the standard under 35 USC § 135(b) for Claim 33. Specifically, Claim 33 requires very specific steps involving specified classes of data (variable and constant) being handled in very specific locations (main computer vs. remote computer). Claim 1 of ‘026 is less specific in some steps and *some of these steps may never occur* due to, among other language, the inclusion of optional-type phrasing (such as the “computer *can* assemble”) and elusive steps involving the decision making regarding data eligibility for storage (“the storage control attribute dictating eligibility of the application data for storage”). These steps constitute different material limitations between the claims. They are patentably distinct and even if one argues they may have been obvious, the standard under 35 USC § 135(b) is not a 35 USC § 103 obviousness standard.

Art Unit: 2153

Patentably distinct

28. The prosecution history of application 08/158,026 also supports a rejection under 35 USC § 135(b) in that Claim 1 of 08/158,026 was not deemed to be "***patentable***." Applicants amended the claim in order to overcome the art of record, U.S. Patent 4,887,204, Johnson et al.. Claim 1 of 08/158,026 was not deemed to be patentable and in light of that fact, "the essential patentable subject matter is [not] the same in each case." *Reiser v. Williams*, 118 USPQ 96, 99 (CCPA 1958) as reiterated in *Berman v. Housey*, 63 USPQ 2d 1023 (CAFC 2002). Therefore Claim 1 and applicants' copied claims are not the same invention and the copied claims were not made prior to one year from the date on which Hill '490 issued.

29. Applicants' "...Supplemental Request for Declaration of an Interference Under 37 C.F.R. § 1.607" filed March 5, 1999 (Paper no. 5) contains a statement on p. 6 regarding the prosecution of application 08/158,026:

Applicants' amended Claim 1 was rejected but Applicants did not acquiesce to unpatentability of amended Claim 1 and expressly traversed the Examiner's rejections in their grandparent application. A decision was made ***to forego prosecution of the claim*** as it existed to advance the case to issue. Applicants did not file a continuation application at that time to continue prosecution of amended Claim 1 ***for financial reasons***. (Emphasis added.)

In reviewing this statement, two items are of interest: first, Claim 1 **was** further prosecuted with an amendment by applicants in April 1996 which resulted in the examiner of record making a determination that Claim 1 was then allowable. Second, it is difficult to understand applicants' contention that financial reasons forestalled applicants from pursuing allowable subject matter. It is noted applicants' assignee is IBM, the same company that has historically ranked at the top of companies with patents obtained with the USPTO for a number of years. Even in this tree of related applications branching from original application 07/219,931, applicants have filed at least 15 separate applications and a number of these applications have progressed to appeal or to patent. So applicants' statements are not found persuasive.

Different claimed inventions

30. Regarding applicants' claimed subject matter in Claims 62-72, there is no support; and applicants do not appear to have presented any arguments regarding how these apparatus claims 62-72 meet the standard of claiming the same or substantially the same subject matter under 35 USC § 135(b). A method claim is not the same as an apparatus claim. Claim 1 of application 08/158,026 is a method claim while Claims 62-72 are drawn to the apparatus of an electronic catalog system. Clearly these are not the same subject matter under 35 USC § 135(b).

31. In addition, Claims 62-72 are drafted in accordance within the guidelines of 35 USC § 112, 6th paragraph, "means plus function."

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

A review of the specification of application 08/158,026 and the Hill '490 patent shows the means utilized are different in each of the disclosures. For example, Hill discloses a very specific mapping means which is not disclosed by applicants (see Hill '490, Col. 20, line 43 *et seq.* which discloses the mapping means for the integration – a map file that integrates the data on the customer's computer for the electronic catalog system). This is just one example of many features that are different between applicants' and Hill's disclosures indicating the claimed subject matter of Claims 62-72 are not the same under the analysis of 112, 6th paragraph.

32. For all of the above noted reasons, applicants were not claiming substantially the same subject matter as the issued patent of Hill '490 prior to one year from the date on which Hill '490 was granted.

Response to Applicants' Remarks

33. Applicants included extensive analysis in Paper no. 5, filed March 5, 1999 as to why Claim 33 and Claim 1 are directed to the same subject matter. However, in most of the

Art Unit: 2153

discussion, applicants' remarks regarding Claim 1 of 08/158,026 are much more specific than the claim language or any remarks made during the prosecution history of the grandparent application (which might be construed as statements of something "necessary to patentability." *Corbett v. Chisholm*, 196 USPQ 337, 343 (CCPA 1977).) Applicants have repeatedly referred to the same passages in Claim 1 for a whole host of limitations specifically detailed as steps in Claim 33 and then relied upon broad passages in applicants' disclosure to support the general concepts outlined in Claim 1. For example, applicants rely upon the phrase, "the predetermined plan being implemented, at least in part" as being the same material limitation for virtually every step, location or concept of Claim 33. In fact, Claim 33 contains specific steps that occur in a specific sequence which were omitted in applicants' grandparent filing of Claim 1. Applicants' attempt to capture unclaimed material limitations in hindsight is not permissible and the remarks do not overcome the deficiencies for purposes of a rejection under 35 USC § 135(b).

Information Disclosure Statement

34. The art made of record and not relied upon is considered pertinent to applicant's disclosure.

Prodigy users guide, dated 1990.

References cited by BPAI as 196(b) art in applicants' related application:

- Paul Hurly et al., The Videotex and Teletext Handbook, 1985
- Cleveland Horton, IBM, Sears shooting for '88 entry; New life for videotex, April 6, 1987
- Ellen Forman, Surge seen for electronic shipping, May 21, 1987
- Jerrold Ballinger, Trintex Signs up 42 Advertising Clients: Is Hoping for Launch in Early '88, VP Says, June 1, 1987
- Cleveland Horton, Big advertisers link to videotex venture, June 15, 1987
- Arthur Markowitz, Trintex interactive videotex service will feature magazine-type format, June 22, 1987

Art Unit: 2153

- Trintex to Aim On-Line Ads at Demographic Segments, June 30, 1987
- Inside Trintex: Technology & Operations supplement, Sep 8, 1987
- David Kiley, Trintex: Videotex Gets Personalized, October 12, 1987.
- Scott Mace, Trintex System Offers Access to Variety of Consumer Services, Nov 30, 1987

Hill v. CompuServe, 57 USPQ2d 1021 (S.D. Ind. 2000)(unpublished); *aff'd, rev'd-in-part, vacated-in-part, and remanded*, 33 Fed. Appx. 527; 2002 U.S. App. Lexis 6895 (CAFC 2002).

Johnson et al., 4,887,204 used to reject applicants' earlier claims in application 08/158,026.

Anderson et al., 4,460,960 combines constant (pre-stored messages) with dynamic data (messages from the server) to create a display. The reference does not appear to teach updating the constant data.

Conclusion

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung Dinh whose telephone number is (703) 305-9655. The examiner can normally be reached on Monday - Thursday from 7:00 AM to 4:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone ***regarding this application only*** are unsuccessful, contact the Special Programs Office, Josie A. Ballato, who can be reached on (703) 308-0269.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2100 Customer Service Office whose telephone number is 703-306-5631.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

Art Unit: 2153

or faxed to:

(703) 746-7239, (for formal communications intended for entry)

(703) 746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (Receptionist).



Dung Dinh

Primary Examiner

November 6, 2002